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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,669	02/25/2005	James Stanley Campbell	056258-5090	7648

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MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

EXAMINER

KLEMANSKI, HELENE G

ART UNIT PAPER NUMBER

1755

DATE MAILED: 10/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/525,669

Applicant(s)

CAMPBELL ET AL.

Examiner

Helene Klemanski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 18, 22-24 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 18, 22-24 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/25/05 & 7/29/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Claims 3 and 5-13 have been amended, claims 14-17, 19-21 and 25 have been deleted and no new claims have been added. Hence, claims 1-13, 18, 22-24 and 26 are pending in the application.

Information Disclosure Statement

2. The references cited in the Search Report dated November 14, 2003 have been considered.

Claim Objections

3. Claims 1, 3, 4, 6 and 7 are objected to because of the following informalities: in claim 1, the third line after the formula I, the left parenthesis should be deleted; also in claim 1, the eighth line after formula I, the right parenthesis should be deleted; further in claim 1, the ninth line after the formula I, the left parenthesis should be deleted; lastly in claim 1, the fourteenth line after formula I, the right parenthesis should be deleted; in claim 6, line 4, the phrase "as defined in claim 1" should be deleted; in claim 7, line 2, the phrase "J is phenyl, optionally substituted" should be replaced with the phrase "J is an optionally substituted phenyl".

The following phrases are also being objected to because of the following reasons:

(1) in claim 3, line 3, the phrase "more preferably from 800 to 1000nm" and

(2) in claim 4, line 2, the phrase "preferably at least 95%".

Applicants should note that the terms "preferably", "more preferably" and "such as" and the phrases that follow them do not further limit the claims. For example, in claim 3, it is the examiner's position that the compound has an electronic absorption peak from 750 to 1100nm and the remaining amounts after the term "preferably" does not extend the scope of that claim. The examiner suggests the deletion of the above phrases and adding each limitation as a new dependent claim. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 6 and 8-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 6 and 8-10, the phrase "selected from" is considered indefinite since this is improper Markush language. It is the examiner's position that other materials could be present in the Markush group that were not intended by applicants by the use of the phrase "selected from" since this phrase does not exclude other materials. Applicants should note that claim 1 has four occurrences and claim 10 has two occurrences of the phrase "selected from". All the other claims have one occurrence.

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The examiner suggests the language "selected from the group consisting of" in place of this phrase.

Double Patenting

6. Applicant is advised that should claim 18 be found allowable, claim 26 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

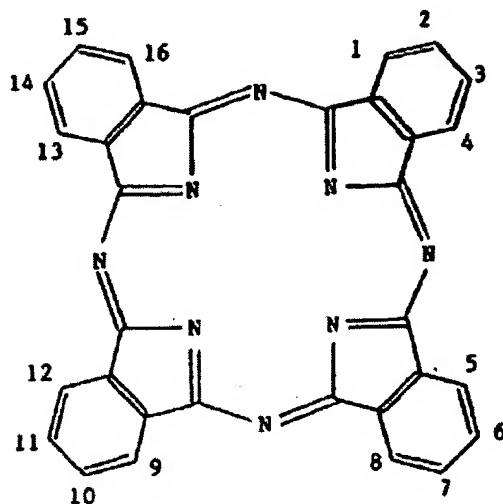
7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-13, 18, 22 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0155780.

EP 0155780 teaches an infra-red absorbing phthalocyanine compound of the formula



wherein each of at least 5 preferably 8 of the peripheral carbon atoms in the 1, 4, 5, 8, 9, 12 or 16 positions of the phthalocyanine nucleus is linked by an atom such as S, Se, Te or NT where T is H, alkyl or aryl to a carbon atom of an organic radical such as an optionally substituted aliphatic, alicyclic or aromatic radical such as an optionally substituted benzene or naphthalene. The remaining peripheral carbon atoms may carry other substituents such as halogen atoms but are preferably unsubstituted (i.e. are hydrogen). The phthalocyanines may be metal free or it may be complexed with a metal such as vanadyl. The phthalocyanines have an absorption peak in the region from 750 to 1100. The phthalocyanine compound is useful in infra-red ink compositions and infra-red security systems. EP 0155780 teaches that a security card can be rendered opaque to infra-red radiation by application to the card of an ink containing the above phthalocyanine compound by thermal transfer or ink-jet printing. See the abstract, page 1, lines 3-36, page 2, lines 21-28, page 3, lines 3-23, page 4, line 5 – page 5, line 1, page 5, line 14, page 7, lines 26-28, page 10, lines 12-19, page 11, lines 1-4, examples 1, 3, 5, 10, 13, 16 and 59 and claims 1-4, 6-8, 10 and 15. The

phthalocyanine and ink composition containing the phthalocyanine compound as taught by EP 0155780 teach appears to anticipate the present claims.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0155780 in view of Albert et al. (US 5,282,894).

EP 0155780 is cited and relied upon for the above stated reasons. EP 0155780 fails to teach the addition of a colorant or an acrylate monomer to the infra-red ink composition as claimed by applicants.

Albert et al. teach a liquid printing ink for security printing comprising a similar phthalocyanine dye, a solvent, a binder such as polyacrylate or polymethacrylate and optionally a colorant. See col.1, line 5 – col. 2, line 11, col. 9, line 22 – col. 10, line 27, General process II and claim 1.

Therefore, in view of the combined teachings of EP 0155780 and Albert et al., it would have been obvious to one having ordinary skill in the art to have modified the ink composition of EP 0155780 by adding the binder and a colorant since Albert et al. shows that these additives are conventional components of security ink compositions.

Conclusion

The remaining references listed on forms 892 and 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the above rejections.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helene Klemanski whose telephone number is (571) 272-1370. The examiner can normally be reached on Monday-Friday 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Helene Klemanski
Primary Examiner
Art Unit 1755


HK
October 1, 2006